

### **REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed December 9, 2008. In the Office Action, the Examiner notes that claims 16-32 are pending and rejected.

In view of the following discussion, Applicants submit that all of the claims satisfy the requirements of 35 U.S.C. §112. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response. Applicants respectfully request reconsideration and allowance of the claims in view of the following remarks.

### **REJECTION OF CLAIMS 16-32 UNDER 35 U.S.C. § 112 ¶ 1**

Claims 16-32 are rejected under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection. Applicants respectfully direct the Examiner to Applicants' prior responses. Further to and supplementing the arguments provided in those responses, Applicants provide the following comments and observations:

The Examiner contends that the following claim limitation is not supported by this specification:

"presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing, during presentation of the interactive advertisement;"

The above-quoted claim language refers to the presentation and selectable storage on a storage device of an "interactive advertisement." The "interactive advertisement" is entirely different than the program or event being promoted via that

advertisement. For example, an interactive advertisement may be promoting a future sporting event.

With respect to Examiner's response to Applicants' arguments:

(1) The Examiner misconstrues the terms "advertisements" and "promotional programming" as relating to different types of content. This is simply incorrect. Promotional programming is the same as advertisements.

The instant patent application states that (page 17, line 2) "advertisement or other promotional programming 602 is distributed by a content provider over a distribution network for presentation on a display device 604." Relying on this language, the Examiner contends that the word "or" must be construed as an "exclusive or" rather than an "inclusive or." This is clearly incorrect.

First, the word "or" is not used by itself. The word "or" is used in conjunction with the word "other" such that the term "advertisement" is clearly defined as a form of promotional programming. Therefore, the word "or" is clearly intended to be construed as the "inclusive or" form.

Second, since the reference designator 602 is applicable to the "advertisement or other promotional programming," it is clear that one single element (i.e., advertisement/promotional programming) is referenced and thereby, therefore, the word "or" is clearly intended to be construed as the "inclusive or" form.

Applicants do not understand why the Examiner persists in this convoluted view of so simply stated a term. The plain meaning of the above sentence, especially in conjunction with the use of the term's advertisement, promotional programming and so on throughout the specification clearly indicates that the patent drafter intended the term "or" to be construed as the "inclusive or" form. Moreover, one skilled in the art would have absolutely no difficulty in discerning this.

(2) Support for the claim language is clearly found in at least Figures 3 and 5 and the associated text in the application. Specifically, the metadata structures presented in Figure 3 corresponds to an interactive advertisement metadata structure. It is noted that

only the interactive advertisement metadata structure of Figure 3 (i.e., not the purchasable event metadata structure of Figure 2) includes the following EPG action tags: tune action, store action and record action.

Referring to the instant application at page 14 of, lines 22-23, it is stated that "the terminal stores the meta-data in memory, step 504, where it is parsed to extract the metadata regarding the promotional currently being viewed, step 506." That is, an advertisement currently being viewed has associated with it metadata which is stored in memory.

Referring to further text associated with Figure 5 (last paragraph of page16), at step 532, if the ad storage tag has been parsed the method proceeds to step 534. At step 534, if the "associated graphical control presents the option of saving the advertisement to a storage device" has been selected, then the method proceeds to step 536, where the advertisement is written to a DVR. Thus, an advertisement being presented is stored in a DVR.

The above portions of the specification describing Figure 5 clearly support the storage in a DVR of an advertisement currently being viewed, as claimed. The advertisements comprise interactive advertisements.

As such, Applicants submit that claims 16-32 are patentable under 35 U.S.C. §112, ¶1. Therefore, the rejection should be withdrawn.

### **REJECTION UNDER 35 U.S.C. §103**

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the Graham factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The key to supporting a rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The analysis supporting such a rejection must be explicit. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), cited with approval in *KSR Int'l Co. v. Teleflex, Inc.*, 126 S. Ct. 2965 (2006); see also MPEP §2141.

According to MPEP §2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art" (*quoting, In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). In addition, to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all elements of the subject claim. *In re Wada*, 2007-3733 (BPAI Jan. 14, 2008) (*citing, CMFT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed.Cir. 2003)).

#### **Claims 16-21 and 24-32**

Claims 16-21 and 24-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (U.S. Patent No. 6,317,885, hereinafter Fries) in view of Alexander et al. (U.S. Patent No. 6,177,931, hereinafter Alexander). The rejection is traversed.

The combination of Fries and Alexander fails to establish a *prima facie* case of obviousness, because the combination fails to teach or suggest all the elements of the claimed invention. For example, the combination fails to teach or suggest the claimed option for storing the interactive advertisement on a user-defined storage device.

Claim 16 recites, *inter alia*, "presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing."

Fries fails to teach the claimed option for storing an interactive advertisement on a user-defined storage device. (See Office Action, page 3.)

Alexander fails to teach or suggest the claimed option for storing an interactive advertisement on a user-defined storage device. By contrast, Alexander teaches that the user presses a record button to instruct the EPG to record an infomercial or advertisement to that extent that it is scheduled for a future time, i.e., it is broadcast at a time or on a channel that would be inconvenient for the viewer to watch in real-time. (See Alexander, col. 19, lines 57-65.) Thus, the storage device is not user-defined and the recording in Alexander is under the control of the EPG, not the user. In addition, the claimed invention presents an option to store an interactive advertisement that is being presented, not one scheduled for a future time, as in Alexander. The claimed invention provides more user-control and allows storage of any interactive advertisement being presented, not only ones scheduled for a future time.

Therefore, claim 16 is patentable over the combination of Fries and Alexander under §103.

Claims 17-26 depend, directly or indirectly, from claim 16 and, thus, inherit the patentable subject matter of claim 16, while adding additional elements and further defining elements. Therefore, claims 17-26 are also patentable over the combination of Fries and Alexander under §103 for at least the reasons given above with respect to claim 16.

Claim 27 recites, *inter alia*, "a user-defined storage device for storing the interactive advertisement, when the user selects an option to store the interactive advertisement for future viewing, during the presentation of the interactive advertisement." For the same reasons given above with respect to claim 16, claim 27 is patentable over the combination of Fries and Alexander under §103.

Claims 28-32 depend, directly or indirectly, from claim 27 and, thus, inherit the patentable subject matter of claim 27, while adding additional elements and further defining elements. Therefore, claims 28-32 are also patentable over the combination of Fries and Alexander under §103 for at least the reasons given above with respect to claim 27.

**Claims 22-23**

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fries in view of Alexander in further view of Lawler et al. (U.S. Patent No. 5,699,107, hereinafter Lawler) in further view of Matthews, III et al. (U.S. Patent No. 6,025,837, hereinafter Matthews). The rejection is traversed.

Each ground of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. 103 given Fries in view of Alexander. Since the rejection under 35 U.S.C. 103 given Fries in view of Alexander has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that the additional references supply that which is missing from Fries in view of Alexander to render the independent claims obvious, these grounds of rejection cannot be maintained. Therefore, claims 22-23 are patentable over the combination of Fries, Alexander, Lawler and Matthews under §103 for at least the reasons given above with respect to claim 27.

**CONCLUSION**

For the foregoing reasons, Applicants respectfully request reconsideration and passage of the claims to allowance. If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 842-8110 X120 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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